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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,709	08/31/2001	James Stephen Shaw	13DV14194	1772
29827	7590	10/22/2003	EXAMINER	
FRANCIS L. CONTE, ESQ. 6 PURITAN AVENUE SWAMPSCOTT, MA 01907			COONEY, JOHN M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/944,709

## Applicant(s)

SHAW ET AL.

## Examiner

John m Cooney

## Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,12,16-18 and 22-43 is/are allowed.
- 6) ☒ Claim(s) 1-10,13-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant's arguments filed 8-8-2003 have been fully considered but they are not persuasive.

Rejections are maintained as set forth below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 rejected under 35 U.S.C. 102(e) as being anticipated by Reichelt et al. (6,495,652).

Reichelt et al. discloses foamed articles prepared from prepolymers which offer the permissible inclusion of cellulose fibers, metal fibers, and other abrasive additives in the reactive components, water, and toluene diisocyanate and polyether based prepolymers (see the entire document). Reichelt et al. is seen to anticipate imbedding since it acknowledges addition of the cellulose fibers to the reactive mixtures, and the claim offers no definition of a distinctive imbedded state. Chemical bonding of the

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cellulose fibers is seen to be inherent to its inclusion absent some showing of distinction between the fibers of applicants' claims. Water catalysis is inherent to the presence of water in the reactive mixtures because it is the reaction of water with the prepolymers that results in its blowing agent effect.

Claims 1-10 rejected under 35 U.S.C. 102(e) as being anticipated by Keppeler et al. (5,981,612).

Keppeler et al. discloses foamed articles prepared from prepolymers which offer the permissible inclusion of cellulose fibers, metal fibers, and other abrasive additives in the reactive components, water, and toluene diisocyanate and polyether based prepolymers (see the entire document). Keppeler et al. is seen to anticipate imbedding since it acknowledges addition of the cellulose fibers to the reactive mixtures, and the claim offers no definition of a distinctive imbedded state. Chemical bonding of the cellulose fibers is seen to be inherent to its inclusion absent some showing of distinction between the fibers of applicants' claims. Water catalysis is inherent to the presence of water in the reactive mixtures because it is the reaction of water with the prepolymers that results in its blowing agent effect.

Applicants' arguments have been considered. However, rejections are maintained as set forth above. Applicants' argue that the listing of materials within which cellulose fibers are included is extensive. However, examiner holds that the

comprehensiveness of a reference does not derogate from its teaching effect. *Ex parte A 17 USPQ2d 1717.*

Applicants' claim language directed towards "cellulose fibers being imbedded therein" is acknowledged and has been considered. However, the limitation, as it currently stands, merely requires the that the fibers be within the structure of the polymeric sponge. The specification does not give this language definition beyond such, and limitations can not be inferred from this language beyond what is specifically defined.

Applicants' arguments regarding specific dependent claims have been considered. Regarding the arguments directed towards the limitation of the predominate presence of closed cells (claim 6), the references, again, must be taken for their full teaching, and their comprehensiveness does not derogate from their teaching effect. The references' disclosed articles are held to inherently encompass closed cell foams owing to their disclosed products obtained.

Regarding the arguments directed towards the exclusion of surfactants (claim 7), the references' indicate these to be additional "if desired", hence, optional, and, therefore, not mandatory. Exclusion of bonding agents as specified in claim 9 is maintained to be within the teachings of the cited references for this reason, as well.

Applicants' new claim limitation "comprising pliant cellular granules" does not distinguish the claims over the cited prior art. The limitation does not define "granules" in a manner which distinguishes over the "articles" of the references, and the term

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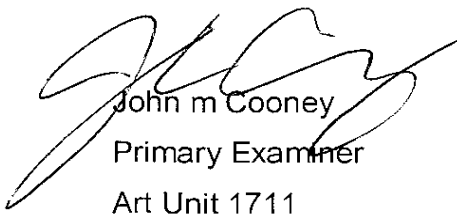
"pliant" without specific values of degree does not present a limitation in the patentable sense.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John m Cooney whose telephone number is 703-308-2433. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, james seidleck, can be reached on (703) 308-2462. **Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.** The centralized facsimile number is **(703) 872-9306**. The changes are effective October 1, 2003.

  
John m Cooney  
Primary Examiner  
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